

REMARKS

Pursuant to the present amendment, new claims 21-23 have been added. Thus, claims 1-23 are pending in the present application. No new matter has been introduced by way of the present amendment. Reconsideration of the application is respectfully requested.

In the Office Action, claims 1-20 were rejected under 35 U.S.C. § 103 as allegedly being unpatentable over Harris (U.S. Patent Publication No. 2003/0050703) in view of Errico (U.S. Patent No. 5,667,508). Applicants respectfully traverse the Examiner's rejections.

As the Examiner well knows, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); M.P.E.P. § 2142. Moreover, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988); M.P.E.P. § 2143.03.

With respect to alleged obviousness, there must be something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination. *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561 (Fed. Cir. 1986). In fact, the absence of a suggestion to combine is dispositive in an obviousness determination. *Gambro Lundia AB v. Baxter Health-*

care Corp., 110 F.3d 1573 (Fed. Cir. 1997). The mere fact that the prior art can be combined or modified does not make the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990); M.P.E.P. § 2143.01. The consistent criterion for determining obviousness is whether the prior art would have suggested to one of ordinary skill in the art that the process should be carried out and would have a reasonable likelihood of success, viewed in the light of the prior art. Both the suggestion and the expectation of success must be founded in the prior art, not in the Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); *In re O'Farrell*, 853 F.2d 894 (Fed. Cir. 1988); M.P.E.P. § 2142.

By virtue of the lack of a § 102 rejection, the Examiner concedes that the subject matter of the pending claims is novel. Applicant respectfully traverses the Examiner's § 103 rejection. As an initial matter, it is respectfully submitted that there is no motivation to combine the teachings of Harris and Errico as suggested by the Examiner. First, Harris is directed to the replacement of hip joints, and it discloses an acetabular shell (52), liner (54) and constraining ring (56). On the other hand, Errico is directed to a locking cap mechanism that is used with pedicle screws and rod assemblies commonly used as an immobilization assembly for the spine. Errico, Col. 1, ll. 20-47; Col. 2, ll. 28-35. The present invention is directed to retaining a femoral ball that moves within the cavity of an acetabular insert. Errico is directed to a locking nut for an immobilization assembly commonly used in treating injuries to the spine. It is simply not understood why one skilled in the art, when trying to solve the problems associated with retaining a moving femoral ball within an acetabular insert, would be motivated to look to prior art like that embodied in Errico – prior art that is directed to immobilization assemblies. It is respectfully submitted that there is no such motivation in the prior art.

A recent Federal Circuit case makes it crystal clear that, in an obviousness situation, the prior art must disclose each and every element of the claimed invention, and that any motivation to combine or modify the prior art must be based upon a suggestion in the prior art. *In re Lee*, 61 U.S.P.Q.2d 143 (Fed. Cir. 2002). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. *Id.* at 1434-35. It is respectfully submitted that any attempt to assert that the inventions defined by the pending claims would have been obvious in view of the prior art of record constitutes an impermissible use of hindsight using Applicant's disclosure as a roadmap.

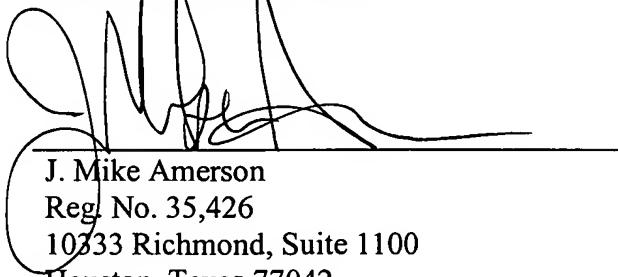
Even if there were motivation to combine Harris and Errico (which there is not), that claimed combination still would not teach each and every limitation of the claimed invention. Accordingly, any such obviousness rejection would be legally improper. The Examiner did not specifically identify (by reference number) which component of Errico constitutes the "extension with triangular cross section" (Office Action, p. 2). It is assumed that the Examiner is referring to the "pie-shaped wedges 229" (Col. 6, l. 65, Figures 5a, 5b and 7). The wedges 229 in Errico are used to secure the post portion 240 within the upstanding legs 102b, 104b (see Figure 7). The wedges 229 accomplish this purpose by having the end deflect inward into the annular recesses 250 formed on the post 240. Col. 7, ll. 5-22.

New dependent claims 21-23 have been added to further define Applicants' invention. These new dependent claims add very detailed limitations with respect to the structure of the inner and outer surfaces recited in the claims. It is respectfully submitted that there is certainly no suggestion in the art of record for the invention defined by these claims. Allowance of these new dependent claims is also respectfully requested.

In view of the foregoing, it is respectfully submitted that all claims pending in the present application are in condition for immediate allowance. The Examiner is invited to contact the undersigned attorney at (713) 934-4055 with any questions, comments or suggestions relating to the referenced patent application.

Respectfully submitted,

WILLIAMS, MORGAN & AMERSON
CUSTOMER NO. 45488



J. Mike Amerson
Reg. No. 35,426
10333 Richmond, Suite 1100
Houston, Texas 77042
(713) 934-4056
(713) 934-7011 (facsimile)

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ATTORNEY FOR APPLICANTS